

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KIRK TECU and WILLIAM ROBERT HAAS

Appeal 2007-0902
Application 10/077,500
Technology Center 2600

Decided: June 25, 2007

Before LEE E. BARRETT, JOSEPH L. DIXON, and JEAN R. HOMERE,
Administrative Patent Judges.

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's Final Rejection of claims 1-22. Claims 23 and 24 have been indicated as allowed by the Examiner. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM and enter a NEW GROUNDS OF REJECTION.

BACKGROUND

Appellants' invention relates to a camera that uses flash illumination to assist in a composition. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A camera comprising a strobe for supplying light to a scene, the strobe flashing repeatedly throughout composition of a photograph.

PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Iwai	US 5,198,855	Mar. 30, 1993
Umeda	US 5,920,342	Jul. 6, 1999
Tanaka	US 2001/0043277A1	Nov. 22, 2001
Matsui	US 2002/0048457A1	Apr. 25, 2002
		(filed Oct. 22, 2001)

REJECTIONS

Claims 1-3, 5-7, 11-13, and 15-19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka in view of Matsui.

Claims 4 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tanaka in view of Matsui and Iwai.

Claims 8-10 and 20-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tanaka in view of Matsui and Umeda.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellants regarding the above-noted rejections, we refer to the Examiner's Answer (mailed Aug. 28, 2006) for the reasoning in

support of the rejections, and to Appellants' Brief (filed Jul. 20, 2006) and Reply Brief (filed Sep. 27, 2006) for the arguments thereagainst.

OPINION

In reaching our decision in this Appeal, we have given careful consideration to Appellants' Specification and claims, to the applied prior art references, and to the respective positions articulated by Appellants and the Examiner. As a consequence of our review, we make the determinations that follow.

35 U.S.C. § 103

With respect to the role of the Examiner as finder of fact, the Court of Appeals for the Federal Circuit has stated: "the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The Court of Appeals for the Federal Circuit has also noted: "[w]hat the prior art teaches, whether it teaches away from the claimed invention, and whether it motivates a combination of teachings from different references are questions of fact." *In re Fulton*, 391 F.3d 1195, 1199-1200, 73 USPQ2d 1141, 1144 (Fed. Cir. 2004) (internal citations omitted). In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). Furthermore, "there must be some articulated reasoning with some rational underpinning to support the legal

conclusion of obviousness' [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1337 (Fed. Cir. 2006)).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. “[T]he name of the game is the claim.” *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations as recited and disputed in independent claim 1. From our review of the Examiner’s rejection, we find that the Examiner has set forth a proper initial showing, with respect to independent claim 1, to shift the burden to Appellants. We note that the claim limitations in independent claim 1 recite “a camera comprising a strobe for supplying light to a scene, the strobe flashing repeatedly throughout composition of a photograph.” Interpreting the claim in light of Appellants’ Specification, we find that the Specification is replete with alternative embodiments and the use of “may” thereby giving a wide range of interpretation to the claim language. We note that the Specification at page 4, lines 14-16, states that the “camera flashes the strobe (106) one or more times during the time the photographer is composing a photograph, thus providing additional light (107) to the scene.” Here, the Specification states that one flash is sufficient, but the claim language recites “repeatedly” which would entail at least two flashes. We interpret “repeatedly” to be mean “on occasion” or “more than a single time” before a picture is taken.

Appellants argue in the Reply Brief at page 2 that “composing” is defined at page one of the Specification, yet we find the remainder of the Specification uses “may” in describing the composing of a photograph (Specification at pages 4 and 5). Therefore, we cannot agree that the Specification defines or limits “composing” a photograph. Additionally, we note that independent claim 1 does not recite that the photograph is taken. Therefore, we find that repeated use of the flash for testing or fun by a photographer or use of red-eye reduction flashing or infrared distance measurements would be sufficient to meet the language of independent claim 1 since no other steps or structure is recited in the claim language to add context to the claimed invention.

Here, the Examiner has relied upon the teachings of Tanaka and the use of pre-light emissions and use of the electronic view finder (EVF) for the repeated flashing of the camera strobe. The Examiner maintains that Tanaka shows two pre-light emissions in figure 12 (Answer 4). From our review of figure 12, we find only one pre-light emission and one light emission illustrated in the figure. While not expressly stated by Tanaka, we find that it would have been obvious to one skilled in the art at the time of the invention that if the first pre-light emission showed that the composition of the desired image was not properly framed for the desired picture, then the photographer would again depress the shutter button half way to get another image on the EVF for the same desired image and continue the process until the proper composition of the picture was achieved. Then the photographer would depress the shutter button to the full depressed position and take the final picture [Tanaka paragraphs 0168-0176].

Appellants argue that there is only a single pre-light emission image and a single flash image (Br. 5). We disagree with Appellants as discussed above. Appellants maintain that Tanaka does not teach a strobe flashing throughout the composition of a photograph (Br. 6). We disagree with Appellants as discussed above. It appears that Appellants' arguments imply that there is a circuit which produces a sequence of strobe flashes upon an actuation of an unclaimed element of the camera. We find arguments to unclaimed elements to be unpersuasive.

Appellants argue that the number of flashes or pre-light emissions is irrelevant and the independent claims are concerned with the behavior of the flash (Reply Br. 2). We disagree with Appellants and find that the express language of independent claim 1 merely recites that the strobe repeatedly flashes without limitation on the number or nature of the flash so as to be continual or in a set sequence.

Appellants argue that Matsui is concerned with pre-flash which occurs after the composition of the photograph is complete (Br. 6). We disagree with Appellants due to the non-specific definition of composing a photograph and lack of any elements in the claim which would limit the context of the limitation. We find that Examiner's interpretation to be reasonable. Therefore, Appellants' argument is not persuasive.

Appellants argue that the Examiner has not shown that the flash of Tanaka is long enough for a photographer to evaluate even one live view image (Reply Br. 2-3). We do not find this argument relevant to the claim as recited in independent claim 1 since the length of the flash is not recited in the claim and the evaluation by a photographer is variable and has no relevance to the camera as recited in independent claim 1. Therefore,

Appellants' argument is not persuasive. Since we find no argument advanced by Appellants persuasive of an error in the Examiner's initial showing, we will sustain the rejection of independent claim 1, and dependent claims 2, 3, and 5-7 which Appellants have not set forth separate arguments for patentability.

With respect to independent claim 11, Appellants rely on the same arguments advanced with respect to independent claim 1 which we did not find persuasive (Br. 7). Similarly, we do not find these arguments persuasive with respect to independent claim 11. Therefore, we will sustain the rejection of independent claim 11 and dependent claims 11-13, and 15-18 which Appellants have not set forth separate arguments for patentability.

With respect to independent claim 19, Appellants rely on the same arguments advanced with respect to independent claim 1 which we did not find persuasive (Br. 7). Similarly, we do not find these arguments persuasive with respect to independent claim 19. Therefore, we will sustain the rejection of independent claim 19.

With respect to dependent claims 4 and 14, 8-10, and 20-22, Appellants rely on the arguments advanced with respect to independent claim 1 and contend that the teachings of Iwai and Umeda do not remedy the argued deficiencies in the base combination (Br. 8). Since we found no deficiency in the base combination, we do not find this argument persuasive, and we will sustain the rejection of dependent claims 4 and 14, 8-10, and 20-22.

With this as a background, we additionally enter a New Grounds of Rejection.

NEW GROUNDS OF REJECTION

Pursuant to our authority under 37 C.F.R. § 41.50(b), we have *sua sponte* set forth new grounds of rejection for claims 1, 11, and 19.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in:

35 U.S.C. § 102.

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1, 11, and 19 are rejected under 35 U.S.C. § 102(b) as anticipated by Szajewski (US Pat. 5,875,362).

Szajewski teaches a single use camera which uses its flash as an emergency strobe or for continuous illumination which can be used to illuminate something which is desired to take a flash picture in the dark. (Szajewski claim 1, col. 1, ll. 61-63, col. 2, ll. 55-60, col. 4, ll. 7-11). From our review of the teachings of Szajewski, we find that Szajewski teaches a camera comprising a strobe for supplying light to a scene, the strobe flashing repeatedly throughout composition of a photograph. Here, Szajewski teaches the use of the light to frame a photograph with the continuous illumination. We deem the use of the flashing to also be usable for framing

the same photograph since this is just a desired use of the flash by the photographer.

We leave it to the Examiner to consider the application of Szajewski to the dependent claims and to the claims indicated as allowed by the Examiner.

DECISION

In summary, we have sustained the Examiner's rejection of all the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-22 is affirmed.

We have entered a new grounds of rejection against claims 1, 11, and 19 under 37 C.F.R. § 41.50(b).

As indicated *supra*, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (amended effective September 13, 2004, by final rule notice 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. & Trademark Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides that "A new ground of rejection . . . shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the

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proceeding will be remanded to the
examiner . . .

- (2) Request rehearing. Request that the
proceeding be reheard under § 41.52 by
the Board upon the same record . . .

No time period for taking any subsequent action in connection with
this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED
37 C.F.R. § 41.50(b)

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